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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------|------------------|
| 10/810,526  | 03/27/2004  | Julian James Orbach  | 403104-A-01-US<br>(Orbach) | 1176             |
| 47523   | 7590        | 03/31/2006           | EXAMINER                   |                  |
| JOHN C. MORAN, ATTORNEY, P.C.<br>4120 EAST 115 PLACE<br>THORNTON, CO 80233-2623 |             |                      | DOAN, KIET M               |                  |
|   |             |                      | ART UNIT                   | PAPER NUMBER     |
|   |             |                      | 2617                       |                  |

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/810,526

Applicant(s)

ORBACH, JULIAN JAMES

Examiner

Kiet Doan

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/29/05, 03/27/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

**Claims 1-4, 7, 11-15, 18, 22, 24-26, 33-37, 44, 46-48, 51, 55-56 and 59-60** are rejected under 35 U.S.C. 102(e) as being anticipated by Coombes (Pub. No. 2004/0198461).

Consider **claims 1, 12, 34, 56, 59-60**. Coombes teaches a method for alerting a calling party of a delay before an incoming call will be answered by a user of a called telecommunication terminal, comprising the steps of:

answering the incoming call by the telecommunication terminal in response to an input from the user when the telecommunication terminal is not engaged in another call;

muting an audio path of the answered call from communication with the user (Abstract, Paragraphs [0008] [0012] teach answering incoming call wherein put call on hold/muting an audio path of the answered, further Fig.2, Illustrate step 214 hold call means as detecting call); and

transmitting a message that is selected by the user to the calling party (Paragraph [0011] [0014] teach transmitting PRGM message to the calling party).

Consider **claims 2, 13, 24, 35 and 46**. Coombes teaches the method of claim 1 further comprises the step of maintaining the incoming call from the calling party with the audio path muted to the user; and allowing audio communication by the user with calling party in response to another input from the user (Paragraph [0012] teach call put on hold means as maintaining the incoming call from the calling party and audio/answering normal way by the users).

Consider **claims 3, 14, 25, 36 and 47**. Coombes teaches the method of claim 1 further comprises the step of terminating the incoming call after transmission of the message (Paragraph [0015], Fig.3, illustrate call end No. 314 as terminating wherein after transmission of the message).

Consider **claims 4, 15, 26, 37 and 48**. Coombes teaches the method of claim 1 wherein the message is an audio message and the audio message is transmitted via the audio path to the calling party (Paragraph [0011] teach PRGSM as audio message is transmitted to the calling party).

Consider **claims 7, 18, 29, 40 and 51**. Coombes teaches the method of claim 6 further comprises the step of recording the predefined message (Paragraph [0011] teach recording message).

Consider **claims 11, 22, 33, 44 and 55**. Coombes teaches the method of claim 9 further comprises the step of entering the predefined message (Paragraph [0011]).

**2. Claims 23, 45** are rejected under 35 U.S.C. 102(e) as being anticipated by Cronin (Patent No. 6,216,016).

Consider **claim 23, 45**. Cronin teaches a method for alerting a calling party of a delay before an incoming call will be answered by a user of a called telecommunication terminal, comprising the steps of:

transmitting a message to a wireless switching system in response to the incoming call by the telecommunication terminal in response to an input from the user when the telecommunication terminal is not engaged in another call;

transmitting by the wireless switching system a message that is selected by the user to the calling party; and

placing the incoming call on hold by the wireless switching system (Abstract, C1, L38-61, C3, L17-25, C5, L1-25, Fig.1, teach transmitting message can be done in base station wherein couple to switching center No.11).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 5-6, 9, 16-17, 20, 27-28, 31, 38-39, 42, 49-50 and 53** are rejected under 35 U.S.C. 103(a) as being unpatentable over Coombes (Pub. No. 2004/0198461) in view of Cronin (patent No. 6,216,016).

5. Consider **claims 5, 16, 27, 38 and 49**. Coombes teaches the limitation of claims as discuss above **but silent on** the method of claim 4 further comprises the steps of receiving a time specifying the delay; and inserting the time into a predefined message.

In an analogous art, Cronin teaches "Method and system for generating and transmitting a waiting message". Further, Cronin teaches the method of claim 4 further comprises the steps of receiving a time specifying the delay; and inserting the time into a predefined message (C1, L38-61, C5, L1-25 teach time delay into predefined message).

Therefore, it would have been obvious at the time that the invention was made that person having ordinary skill in the art to modify Coombes and Cronin system, such that to provide means for receiving a time specifying the delay; and inserting the time into a predefined message to provide means for alerting the holder aware that receiving message in time delay.

Consider **claims 6, 17, 28, 39 and 50**. Cronin teaches the method of claim 5 wherein the step of inserting comprises converting the time to audio information for insertion into the predefined message (C1, L38-61, C3, L5-17).

Consider **claims 9, 20, 31, 42 and 53**. Cronin teaches the method of claim 8 further comprises the steps of receiving a time specifying the delay; and inserting the time into a predefined message (C1, L38-61, C3, L5-17, C5, L1-25).

**4. Claims 8, 10, 19, 21, 30, 32, 41, 43, 52 and 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Coombes (Pub. No. 2004/0198461) in view of Cronin (patent No. 6,216,016) and further view Parson et al. (Patent No. 6,704,565).

Consider **claims 8, 19, 30, 41, 52**. Coombes and Cronin teaches the limitation of claims as discuss above **but fail to teach** the method of claim 1 wherein the message is a text message.

In an analogous art, Parsons et al. teaches "Method and apparatus for providing a hold termination message service in a communications network". Further, Parson teaches the method of claim 1 wherein the message is a text message (C4, L46-49, claim 4, teach hold message is a text message).

Therefore, it would have been obvious at the time that the invention was made that person having ordinary skill in the art to modify Coombes, Cronin and Parson system, such that message is a text message to provide means for users easy and convenient to check message without dial into voice mail.

Consider **claims 10, 21, 32, 43 and 54**. Parson teaches the method of claim 8 wherein the transmission of the text message is via a text messaging link (C4, I1-15,

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Claim 4 and claim 10 teach hold message is text via wireless call means as text messaging link).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Kang et al. (Patent No. 6,782,252) teach limitation of claim 23 and 45 (Abstract, C2, L54-67)
2. Huang et al. (Patent No. 6,836,478) teach limitation claims 1, 12, 34, 45 (Abstract, C31, 5-51).

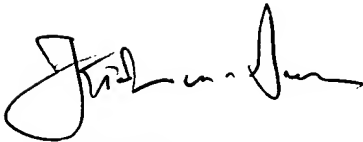
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiet Doan whose telephone number is 571-272-7863.

The examiner can normally be reached on 8am - 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kiet Doan  
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GEORGE ENG  
SUPERVISORY PATENT EXAMINER